



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,725	08/17/2001	Shigeru Yano	018793-251	3808

7590

09/27/2002

Robert G Mukai
Burns Doane Swecker & Mathis
PO Box 1404
Alexandria, VA 22313-1404

EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,725

Applicant(s)

YANO ET AL.

Examiner

Hai Vo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, drawn to a porous film.

Group II, claim(s) 8 and 9, drawn to a method of manufacturing a porous film.

2. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is obvious over Senba et al (US 5,945,210) or JP 11-158305 (see rejections below). As the recited structure does not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate.
3. During a telephone conversation with Robert G. Mukai on 09/20/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8 and 9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senba et al (US 5,945,210) in view of Fujii et al (US 5,015,521) and Shiraishi et al (US 5,656,582). Senba discloses a porous film being formed from a resin composition containing 25 to 70 parts by weight of polyolefin resin, 75 to 30 parts by weight of an inorganic filler, 0.5 to 10 parts by weight of dehydrated castor oil and 0.01 to 5 parts by weight of hardened castor oil based on 100 parts of the composition (abstract). Senba further discloses the polyolefin resin including linear low density polyethylene (column 3, line 57). Senba is silent as to the branched low density polyethylene in the resin composition. Fujii teaches a porous film being formed from a resin composition comprising a blend 10 parts by weight of a branched low-density polyethylene with 90 parts by weight of the linear polyethylene (example 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use branched low-density polyethylene with the linear polyethylene motivated by the desire to improve film-forming properties and stretchability (Fujii, column 3, lines 28-30). Senba teaches the porous film comprising the castor oil in the resin composition (abstract). Senba fails to teach or disclose the presence of liquid ethylene-alpha-olefin oligomer in the resin composition. Shiraishi teaches liquid ethylene-alpha-olefin oligomer is used as a synthetic oil (column 2, lines 61-

63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the ethylene-alpha-olefin oligomer in combination with the castor oil of Senba motivated by the desire to influence the dispersibility of the inorganic filler, the uniformity of the film thickness, stretchability and softness of the film (Senba, column 4, lines 40-49).

With regard to claim 2, since the porous film of Senba as modified by Fujii and Shiraishi is formed from the same resin composition, it is the examiner's position that the viscosity of the ethylene-alpha-olefin oligomer would be inherently present.

With regard to claims 3 and 4, Senba teaches the porous film having the moisture vapor transmission, uniformity of thickness meeting the specific range required by the claims (table 1, example 5).

With regard to claims 5 and 6, since the porous film of Senba as modified by Fujii and Shiraishi is formed from the same resins with the same composition and the porous film having the moisture vapor transmission, uniformity of thickness meeting the specific range required by the claims, it is the examiner's position that the ratio of the rigidity to the thickness as well as the ratio of the extrudation start time to the thickness would be inherently present.

With regard to claim 7, Senba teaches the porous film having a thickness of 40 microns (column 9, line 11).

6. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senba et al (US 5,945,210) in view of Fujii et al (US 5,015,521) and Thakkar et al (US 5,861,211). Senba discloses a porous film being formed from a resin composition

containing 25 to 70 parts by weight of polyolefin resin, 75 to 30 parts by weight of an inorganic filler, 0.5 to 10 parts by weight of dehydrated castor oil and 0.01 to 5 parts by weight of hardened castor oil based on 100 parts of the composition (abstract). Senba further discloses the polyolefin resin including linear low density polyethylene (column 3, line 57). Senba is silent as to the branched low density polyethylene in the resin composition. Fujii teaches a porous film being formed from a resin composition comprising a blend 10 parts by weight of a branched low-density polyethylene with 90 parts by weight of the linear polyethylene (example 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use branched low-density polyethylene with the linear polyethylene motivated by the desire to improve film-forming properties and stretchability (Fujii, column 3, lines 28-30). Senba teaches the porous film comprising the castor oil in the resin composition (abstract). Senba fails to teach or disclose the presence of liquid ethylene-alpha-olefin oligomer in the resin composition. Thakkar discloses a list of lubricating oils including liquid ethylene-alpha-olefin oligomer and castor oil (column 18, lines 45 and 49). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the ethylene-alpha-olefin oligomer in combination with the castor oil of Senba motivated by the desire to influence the dispersibility of the inorganic filler, the uniformity of the film thickness, stretchability and softness of the film (Senba, column 4, lines 40-49).

7. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-158305 in view of Shiraishi et al (US 5,656,582). The page numbers referred to

Art Unit: 1771

below correspond to those of the English translation of the Japanese Patent JP 11-158305. JP'305 discloses a porous film being formed from a resin composition containing (A) 25 to 50 parts by weight of polyolefin resin that includes 75 to 98 wt% of linear low density polyethylene and 2 to 25 wt% of branched low density polyethylene and (B) 75 to 50 parts by weight of an inorganic filler and 0.5 to 10 parts by weight of a lubricant (abstract). JP'305 fails to teach or disclose the presence of liquid ethylene-alpha-olefin oligomer as a lubricant in the resin composition. Shiraishi teaches liquid ethylene-alpha-olefin oligomer is used as a lubricant (column 2, lines 61-63). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the ethylene-alpha-olefin oligomer singly or in combination with the lubricant of JP'305 motivated by the desire to influence the dispersibility of the inorganic filler, stretchability and softness of the film.

With regard to claim 2, since the porous film of JP'305 as modified by Shiraishi is formed from the same resin composition, it is the examiner's position that the viscosity of the ethylene-alpha-olefin oligomer would be inherently present.

With regard to claims 3, 4 and 7, JP'305 teaches the porous film having the moisture vapor transmission, uniformity of thickness, and thickness meeting the specific range required by the claims (page 4, [0025]).

With regard to claims 5 and 6, since the porous film of JP'035 as modified by Shiraishi is formed from the same resins with the same composition and the porous film having the moisture vapor transmission, uniformity of thickness meeting the

Art Unit: 1771


specific range required by the claims, it is the examiner's position that the ratio of the rigidity to the thickness as well as the ratio of the extrudation start time to the thickness would be inherently present.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
September 22, 2002


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700